

REMARKS/ARGUMENTS

Status of the Claims

Claims 1-13 have been cancelled.

Claims 14-24 remain in this application.

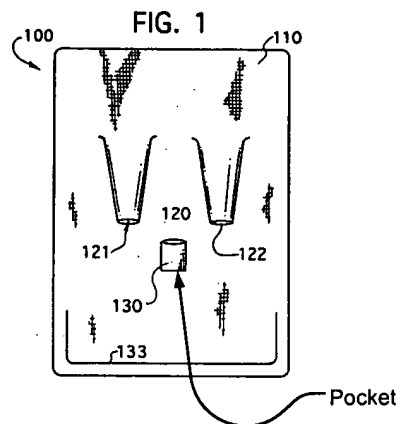
Claims 14 and 20 have been amended.

Claim rejection under 35 U.S.C. § 103(a)

Claims 14, and 17-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,245,717 (Rudy) in view of U.S. Patent No. 777,825 (Wilkes) and further in view of U.S. Patent No. 4,375,111 (Hall).

Applicant respectfully disagrees. However, in the interest of advancing the prosecution of this application, Applicant has amended claim 14 to even more clearly distinguish over the references of record by reciting that the middle portion of the blanket as defined by the panel-forming pocket is about one-third of the width of the blanket and that the pocket is uninterrupted along its width.

The Rudy reference discloses a relaxation article for covering the arms and shoulders of a user to prevent "uncomfortable coolness overtaking the person" in an indoor environment, such as a bedroom. The relaxation article, as shown in Figures 1 and 2, features a flat flexible member 110 having a plurality of openings 111 and a plurality of sleeves 120, which receive the arms of a user. And, contrary to the Examiner's statements at pages 2-4 of the Office Action, Rudy discloses a panel-formed pocket 130 that is "available for the insertion of a book, pen, knitting supplies, etc". (see annotated figure 1 of Rudy below).



Note that Rudy does not provide a pocket for the bottom or inner facing surfaces of his relaxation article (see, figure 2).

Rudy does not show or disclose that his relaxation article is convertible between a blanket and a pillow, as recited in independent claims 14 and 20. Instead, Rudy only discloses a relaxation article.

Rudy does not show or disclose an elongated middle portion having a width that is wholly divisible into the width of his relaxation article, nor does he show or disclose an elongated middle portion that extends the length of his relaxation article along a longitudinal centerline, as recited in independent claims 14 and 20. These features are simply not shown and identified in the figures.

Rudy shows and discloses a pocket 130 that is formed by attaching the side and bottom edges of a panel to his flat flexible member. However the bottom edge of his panel is not substantially coincident with the bottom edge of his relaxation article, as recited in independent claim 14. Instead, the bottom edge of Rudy's pocket is located a considerable distance from the bottom edge of his relaxation article, so that the pocket may be easily accessed by a user's hands.

Moreover, the length of the bottom edge of Rudy's pocket does not substantially define

the width of the middle portion of the blanket, as recited in independent claim 14. Instead, the bottom edge of Rudy's pocket is independent of the middle portion of the blanket and "... may be present at any convenient location such as on the flat flexible member, on a sleeve, etc." (emphasis added).

Rudy's pocket is not designed to receive at least one lower appendage of a user, nor is Rudy's pocket is designed to receive a substantial portion of his relaxation article so that his relaxation article may be converted into a pillow.

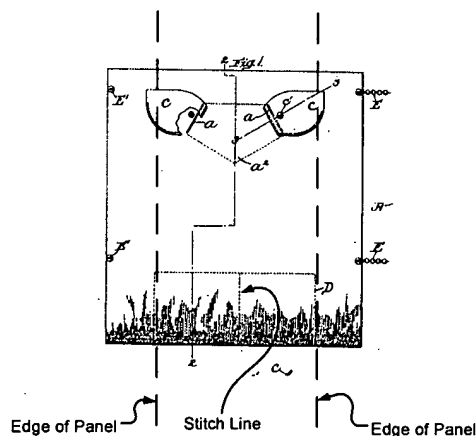
Rudy does not show or disclose sleeves that extend away from each other when the article is arranged in a generally planar configuration. Instead, Rudy's sleeves are parallel to each other when the relaxation article is arranged in a generally planar configuration.

The Wilkes reference adds little. Wilkes shows and discloses a lap robe comprising a front piece A and a back piece B, which are secured about their edges. The front piece A includes "...two oppositely-arranged openings "a", located in the upper part of the robe and at such a distance apart that either one or both hands of a user may be conveniently thrust through the openings when the robe is wrapped about the user." For further protection, Wilkes provides an interlining a¹ between the front and back pieces, with the interlining forming a downwardly projecting pocket a² for receiving and retaining any articles which may be introduced therein. Note the use of "wind-shields" "c", which prevent wind from blowing up the sleeves when the hand is introduced through opening a. Wilkes also provides his robe with a foot piece D that extends across the back of the robe at its lower end, with the foot piece secured along its lower and two side edges. Wilkes discloses in lines 8-10 of column 1, a lap robe of the type "used to protect the lower part of the person when riding in carriages, sleighs, or other conveyances." (emphasis added).

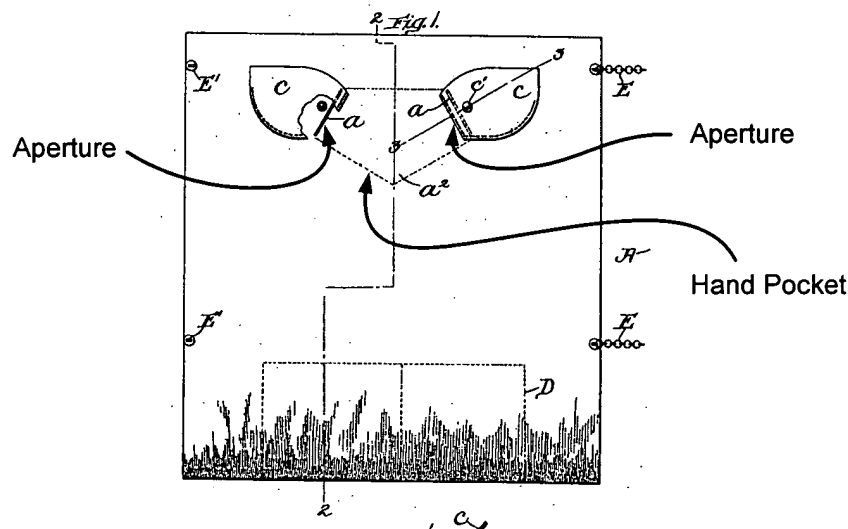
Wilkes does not show or disclose that his lap robe is convertible between a blanket and a pillow, as recited in independent claims 14 and 20. Instead, Wilkes merely discloses a lap robe.

Wilkes does not show or disclose an elongated middle portion having a width defined by longitudinal fold lines so that it is wholly divisible into the width of his lap robe, nor does he show or disclose an elongated middle portion that extends the length of his lap robe along a longitudinal centerline, as recited in independent claims 14 and 20. Rather, Wilkes only shows a cut line 2 that is used to identify the location of a cross-sectional view (figure 2) of his lap robe. An elongated middle portion having a width defined by longitudinal fold lines that is wholly divisible into the width of the lap robe, and a longitudinal centerline are features that are not shown and identified in the figures.

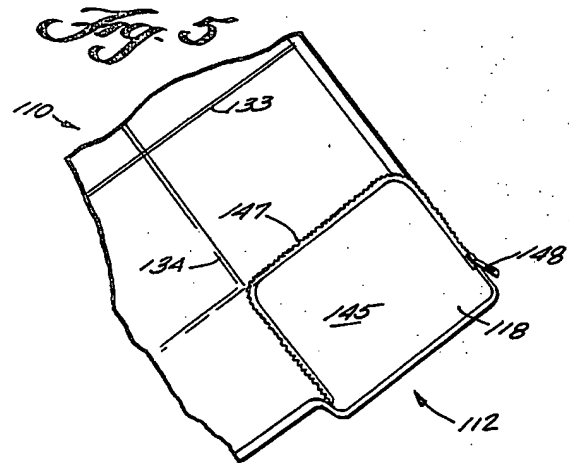
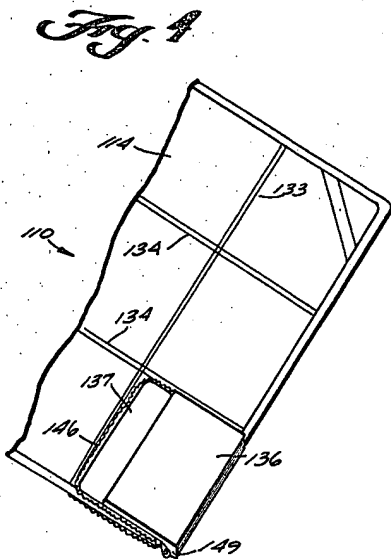
The bottom edge of Wilkes' foot piece D is not substantially coincident with the middle portion of his lap robe. Instead, the bottom edge of Wilkes' foot piece D extends substantially along the width of his lap robe. Note that the dashed lines that depict the foot piece D indicate that there are two foot pockets. Moreover, the edges of Wilkes' foot piece D define a width that is substantially greater than $\frac{1}{2}$ (one half) of the total width of his lap robe (see annotated figure 1 of Wilkes below). In contradistinction, Applicant's claims 14 and 20 recite that the defined middle portion is about one-third the width of the blanket.



Wilkes' apertures "a" are not configured to allow an upper appendage to protrude substantially through his lap robe. Instead, a user's hands are inserted from the front side of his lap robe through apertures "a" and are contained between the front and back pieces of the lap robe in a pocket a^2 . In addition, Wilkes does not show or disclose sleeves.



The Hall reference adds little. Hall shows and discloses a convertible mat and carrying bag combination that comprises a body portion 14 and a head portion 16. The body portion 14 comprises a thin layer of plastic foam 23 sandwiched between first and second nylon sheets includes 21, 22, with the edges of the sandwich held together by a layer of cloth 25, which is stitched thereto. The head portion 16, which is operatively connected to the body portion 14, comprises first and second layers of vinyl or rubber sealed along all of the edges thereof, and a valve 27 that permits the head portion to be inflated or deflated. The mat includes fold lines 33 and 34 to enable the mat to be readily folded into a compact arrangement that can be disposed within the interior volume of a bag 12. In an alternative embodiment fold lines 133 and 134 are shown, and the bag 112 is integrally formed adjacent one of the lower corners of the mat. (figures 4 and 5 of Hall are reproduced below).



It is well settled that “[c]ombining prior art references without evidence of ... a **suggestion, teaching, or motivation** simply takes the inventor’s disclosures as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight”¹.

Contrary to what the Examiner asserts, it would not have been “obvious to one having ordinary skill in the art at the time of the invention to employ a panel as taught by Wilkes with the blanket of Rudy in order to protect the feet and ankles and prevent the robe from being displaced or disarranged at it’s lower end by the user arranging the blanket about the feet”. This would involve moving Rudy’s panel 130 from a location that is conveniently located for access by a user’s hands (i.e., the middle of the relaxation article) to a point at the bottom of the relaxation article. It would also involve positioning the pocket on an interior facing side of the relaxation article, and thus be harder to access. Such a modification would destroy the function of pocket 130 of reference of Rudy.

¹ In re. Dembiczak, 175F3d. 994, 50 USPQ2d. 1614

Rudy is not particularly concerned with the feet of his user. Rudy is primarily concerned with the arms and shoulders of his user. More specifically, Rudy is concerned with people who are indoors, laying in bed or sitting on an easy chair, and whose arms and shoulders become cold due to inactivity.

Wilkes, on the other hand, is concerned about the legs and feet of a user and not the arms and shoulders of a user. More specifically, Wilkes is only concerned with people who are outdoors, riding in an open conveyance and subject to inclement weather, such as snow, rain, and high winds. Wilkes provides his lap robe with foot pockets as a way of avoiding the necessity "for the user to take the usual care in arranging the robe about the feet" due to the inclement weather. Wilkes is so concerned with inclement weather that he provides chains E and hooks E¹ that hold the lap robe snugly about the legs and feet of the user. Thus, Wilkes teaches that his lap robe is attached to the legs and feet of a user.

There is no teaching, suggestion, or motivation to combine the references of Rudy and Wilkes other than the Examiner's broad conclusory statement that it would have been obvious to one of ordinary skill in the art at the time of the invention in order to "protect the feet and ankles and prevent the robe from being displaced or disarranged at its lower end by the user arranging the blanket about the feet." Such a modification is not suggested by Rudy or Wilkes considered alone or in combination, and even if made would not result in Applicant's pillow blanket as set forth in claims 14, and 17-22.

It would also not have been "obvious to employ longitudinal fold lines and pocket as taught by Hall in order to provide a compact storage arrangement which can be disposed within the interior volume of the blanket of Rudy", as asserted by the Examiner.

As explained above, and contrary to the Examiner's statements at pages 2-4 of the Office Action, Rudy does show and discloses a pocket-forming panel 130 that is formed by attaching the side and bottom edges of the panel to his flat flexible member. Note that the bottom edge of his panel is not substantially coincident with the bottom edge of his relaxation article. Instead, the bottom edge of Rudy's pocket is located a considerable distance from the bottom edge of his relaxation article, so that the pocket may be easily accessed by a user's hands.

Moreover, the bottom edge of Rudy's pocket is not substantially coincident with the middle portion of his relaxation article. Instead, the bottom edge of Rudy's pocket is independent of the middle portion of the blanket and "... may be present at any convenient location such as on the flat flexible member, on a sleeve, etc." (emphasis added).

Rudy's pocket is not designed to receive at least one lower appendage of a user, nor is Rudy's pocket is designed to receive a substantial portion of his relaxation article so that his relaxation article may be converted into a pillow.

Assuming arguendo, that modification of Rudy based on the Hall reference were possible, the resultant combination would reposition Rudy's panel 130 to a lower corner on the front surface of the relaxation article where it would be inconvenient to access, and would not provide a panel defining the width of a middle portion of the blanket as called for in claim 14. Moreover, in order for the repositioned panel to function as a bag for the relaxation article as taught by Hall, only the bottom edge of the panel could be connected to the relaxation article, as shown in figures 4 and 5. This means that there would be no pocket structure formed by the panel and the relaxation article, as modified by Hall. Hall's pocket is only formed after his mat has been folded and the zipper slider 148 connects first and second rows of teeth 146, 147. Thus, when a user is wearing the modified relaxation article, he/she will not have any place to insert his/her lower

appendages because no defined pocket exits.

Wilkes discloses a two compartment, stitched pocket "D" that is interrupted by central longitudinal stitching, thus rendering the pocket incapable of receiving a folded robe. In contrast, claim 14, as amended, states that the pocket is uninterrupted along its width.

Dependent claims 17-19, 21, and 22 include further limitations to independent claims 14 and 20. It is respectfully submitted that claims 14, and 17-22 are not obvious in view of Rudy, Wilkes, and Hall, and Applicant respectfully requests that rejection of the claims under 35 USC. 103(a) be withdrawn and passed to issue or, in the alternative, reconsidered and further examined.

Claim rejection under 35 U.S.C. § 103(a)

Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,245,717 (Rudy) in view of U.S. Patent No. 777,825 (Wilkes), U.S. Patent No. 4,375,111 (Hall), and further in view of U.S. Patent No. 6,219,847 (Aikins), with the Examiner taking the position that:

Claim 23, Rudy discloses all of the Applicant's claimed limitations except for at least one of the second ends of the pair of sleeves comprising an expandable cuff. Aikins discloses a blanket with a cuff 17 on the ends of a pair of sleeves. It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the cuff as taught by Aikins with the blanket of Rudy in order to cover the wrists of a user. It is well known to employ expandable fabrics in the construction of cuffs and it would have been obvious for one having ordinary skill in the art at the time of the invention to employ an expandable fabric in order to provide a cuff to provide a snug fit around the wrist of any user.

(emphasis added).

As to the reference of Aikins, Aikins does not show or disclose a blanket. Rather, Aikins

shows and discloses a cocoon garment that is designed and configured to be worn by a user, and which comprises a tubular body that has a neck opening and a pair of sleeves having narrowed cuffs 17. In view of the fact that there are no apparent differences between the cuffs 17 of Aikins and cuffs 122 of Rudy, the particular relevance of Aikins is not understood.

Contrary to what the Examiner asserts, it would not have been obvious for one having ordinary skill in the art at the time of the invention to employ an expandable fabric in order to provide a cuff to provide a snug fit around the wrist of any user.

There is no teaching or suggestion in the references of Rudy or Aikins that their cuffs could be made of expandable material, nor is there any motivation to do so. There is only the conclusory assertion by the Examiner, using Applicant's disclosure as a roadmap, that it would have been obvious to provide the combination of Rudy and Aikins with expandable cuffs.

It is respectfully submitted that claim 23 is not obvious in view of either of the combinations of Rudy, Wilkes, Hall, and Aikins, or Rudy and Aikins, and Applicant respectfully requests that rejection of the claim under 35 USC. 103(a) be withdrawn and passed to issue or, in the alternative, reconsidered and further examined.

Claim rejection under 35 U.S.C. § 103(a)

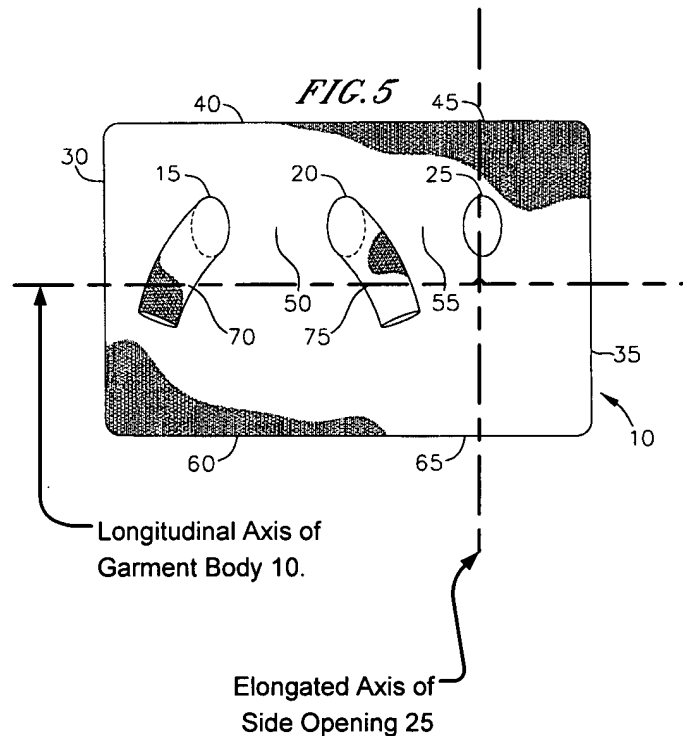
Claims 15, 16, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,245,717 (Rudy) in view of U.S. Patent No. 777,825 (Wilkes), U.S. Patent No. 4,375,111 (Hall), and further in view of U.S. Patent No. 6,006,356 (Song), with the Examiner taking the position that:

Claims 15-16, Rudy discloses all of the Applicant's claimed limitations except for the apertures having an oblong shape and an elongated axis that is parallel to the longitudinal centerline of the blanket. Song discloses a rectangular garment having apertures (15,20) with an oblong shape. It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the oblong shape as taught by Song wherein and an [sic] elongated axis that is parallel to the longitudinal centerline of the blanket of Rudy in order to receive the wearer's arms there-through.

Claim 24, Rudy, as modified, discloses the apertures having an oblique orientation relative to the horizontal centerline of the blanket (fig. 1)(Wikes) [sic]. Rudy fails to disclose the apertures having an oblong shape. Song discloses a rectangular garment having apertures (15,20) with an oblong shape. It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the oblong shape as taught by Song wherein and an [sic] elongated axis that is parallel to the longitudinal centerline of the blanket of Rudy in order to receive the wearer's arms there-through.

(emphasis added).

The reference of Song adds little. Song shows and discloses a wraparound garment that is configured to be wound about the torso of a user. There is a plurality of apertures 15, 20, and 25 in the garment of Song that are configured to receive a user's arms. The apertures have elongated axes; however, the axes of Song's apertures are not parallel to the longitudinal centerline of Song's garment. This is because the longitudinal centerline of Song extends from edge 30 to edge 35 along the longest dimension of the garment. If anything, Song's elongated axes are perpendicular to the longitudinal centerline of his garment (see annotated drawing of figure 5 of Song below).



Moreover, there is no motivation to provide the reference of Rudy with the apertures of Song. Rudy already has apertures or openings that are "... desirably large, say, about double the size of sleeve openings as present on shirts or blouses so that there is ample room should the user fall asleep; thus, circulation or nerve impulses might not be readily impeded." (emphasis added). There is not motivation to provide oblong apertures other than the Examiner's conclusory assertion that it would have been obvious. The only thing obvious is that the openings of Rudy's relaxation article already achieve their intended use. There is no need for any modification of Rudy's openings whatsoever.

It is respectfully submitted that claims 15, 16, and 24 are not obvious in view of Rudy, Wilkes, Hall, and Song, and Applicant respectfully requests that rejection of the claims under 35 USC. 103(a) be withdrawn and passed to issue or, in the alternative, reconsidered and further examined.

Regarding the Examiner's Response to Arguments

The mere fact that a blanket can be folded up and placed into a separate bag for possible use as a pillow, as suggested by the Examiner, is of the moment. That is not what Applicant is claiming. Applicant is claiming a "convertible pillow blanket". In that regard, only the alternative embodiment of Hall as shown in figures 3-5 should be considered. And, upon review of figures 3-5 and the specification it should be quite apparent that Hall does not show or disclose any pocket structure that is formed at the middle portion of his mat. Moreover, it would be impossible for the Hall reference to be formed into a pillow in the manner recited in claim 17.

The Wilkes reference has been discussed above. See, for example pages 9-10.

With regard to the comment "[c]ontrary to the Applicant's argument, Song does disclose sleeves extending away from each other when the article is arranged in a planar configuration". **Not True!** The reference of Song was never cited by the Examiner to show sleeves that extend away from each other when the article is arranged in a planar configuration. The reference of Song was cited by the Examiner because it showed "apertures (15, 20) having an oblong shape" (see page 6 of the Office Action dated July 13, 2004). Applicant's treatment of the combination rejection that included the secondary reference of Song is at pages 16-17 of the response mailed December 2, 2004, and has been repeated above at pages 16-17.

With regard to intended use, "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim."² Since the preambles of independent claims 14 and 20 are necessary to give life, meaning, and vitality to the body of their

² *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

respective claims, they should be construed as if in the balance of the claims. Moreover, "[a]ny terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation".³

CONCLUSION

On the basis of the foregoing amendments, remarks, and arguments of record, applicant respectfully submits that claims 14-24 are in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Alternatively, if the Examiner is of the opinion that prosecution of the application may be expedited by a telephonic interview, the Examiner is invited to contact applicant's representative at the telephone number listed below.

Respectfully submitted,
For the Applicant
By their Attorneys,

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³ *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)